

DISCUSSION OF THE AMENDMENT

The specification has been amended to update the status of the parent application.

No new matter has been added by the above amendment. Claims 10-18 remain pending in the application.

REMARKS

As recited in Claim 17, the invention is an optical element which comprises an optical substrate and a cured film made of a coating composition formed on the surface of the optical substrate, wherein the coating composition comprises, as component (A), at least one particular silicon-containing substance, as recited therein, and, as component (B), colloidal particles of a modified metal oxide which have primary particle diameters of from 2 to 100 nm and which contains particles (c) comprising colloidal particles (a) of a metal oxide having primary particle diameters of from 2 to 60 nm, as nuclei, and a coating material (b) consisting of colloidal particles of an acidic oxide coated on the surface of the particles (a).

As more fully discussed below, the prior art neither discloses nor suggests the colloidal particles of the present claims.

The rejection of Claims 10-18 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, WO/39253, as evidenced by U.S. 6,296,943 (Watanabe et al '253), is respectfully traversed. Watanabe et al '253 is from the same patent family as JP-A-10-310429, described in the specification herein at page 3, lines 10-11. Applicants note that Watanabe et al '253 disclose various composite sols; however, Watanabe et al '253 discloses no sols in the form of colloidal particles having an acidic oxide coated on the surface thereon. The specification herein contains comparative data between the present invention and subject matter outside the terms of the present invention. Included therein is Comparative Composition Example 3, which describes the use of the sol disclosed in Watanabe et al '253, at page 67, lines 10-17 of the specification. Various properties were evaluated, the results being shown in Table 2 at page 70 of the specification. Applicants describe, *inter alia*, that “[t]he optical element of Comparative Composition Example 3 was not particularly inferior practically, but was slightly inferior to the optical elements of Composition Examples 1 to 6,” at page 71, lines 10-14. Reliance on this data is not for the

purposes of overcoming a *prima facie* case of obviousness, but simply to demonstrate that the present invention is different from that disclosed by Watanabe et al '253. There is no disclosure or suggestion in Watanabe et al '253 to form the above-discussed colloidal particles of an acidic oxide coating. In addition, the above-discussed comparative data shows that the Examiner's finding that “[s]aid salts or alkoxides in acid media would have been expected to have formed colloidal acidic oxides via at least some hydrolysis and condensation of the salts and/or alkoxides and would have coated the particles previously set forth as (B),” is incorrect. Note additionally that in the examples of Watanabe et al '253, no further reaction of the composite sol therein appears to take place.

For all the above reasons, it is respectfully requested that this rejection be withdrawn.

The rejection of Claims 10-13 and 16-18 under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103(a) as obvious over, EP 0909784 (Watanabe et al '784), is respectfully traversed. Watanabe et al '784 discloses an anhydrous zinc antimonate sol comprising surface-modified anhydride zinc antimonate colloid particles dispersed in a liquid, the surface-modified anhydrous zinc antimonite colloid particles comprising anhydrous zinc antimonite colloid particles as nuclei and a silicon-containing substance coating surfaces of the colloid particles (Abstract). While the Examiner refers to Watanabe et al '784's disclosure of the use of acidic sols having a primary particle diameter of 2 to 200 nm as the antimony oxide sols therein (column 4, lines 34-36), this disclosure is with regard to the formation of the zinc antimonate nuclei (column 4, line 12ff), which are produced by mixing a zinc compound as described, and the colloidal antimony oxide (column 3, lines 42-53). Watanabe et al '784 neither discloses nor suggests the presently-recited coating material (B) consisting of colloid particles of an acidic oxide coated on the surface of their zinc antimonite colloid nuclei particles. Accordingly, it is respectfully requested that this rejection be withdrawn.

The objection to the specification is moot in view of the above-discussed amendment.

Accordingly, it is respectfully requested that it be withdrawn.

All of the presently-pending claims in this application are believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue.

Respectfully submitted,

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